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Paper No. 9

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OFFICE OF PETITIONS

In re Application of :
Kuida, et al. :
Application No. 09/888,182 : **DECISION ON PETITION**
Filed: 22 June, 2001 :
Attorney Docket No.: VPI00-115 US :
:

This is a decision on the petition filed on 17 October, 2001, styled "Petition to Under 37 C.F.R. §1.53(b)" and considered under 37 C.F.R. §1.53(e)¹--notably, however, Petitioner alleges that the drawings found to be missing from the application "are not necessary for the understanding of the subject matter sought to be patented."

For the reasons set forth below, the petition is **GRANTED in part**.²

The application was filed on 22 June, 2001.

On 23 August, 2001, and again on 11 December, 2001, the Office mailed a "Notice of Incomplete Nonprovisional Application" indicating that the application was filed without, *inter alia*, drawings as required under 35 U.S.C. §113 (first sentence).

¹ The regulations at 37 C.F.R. §1.53 provide in pertinent part:
§ 1.53 Application number, filing date, and completion of application.

(e) Failure to meet filing date requirements.

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a time period within which to correct the filing error.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

² Pursuant to Petitioner's authorization, the petition fee (\$130.00) is refunded and the surcharge (\$130.00) is charged to Deposit Account 50-0725.

Petitioner responds:

- with the instant petition stating that the drawings (Figures 1 through 6) found to be missing from the application “are not necessary for the understanding of the subject matter sought to be patented”; and
- a preliminary amendment deleting the references to Figures 1 through 6.

Thus, Petitioner contends, drawings are not necessary for the understanding of the subject matter sought to be patented.

It is the practice of the Office to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for the understanding of the invention under 35 U.S.C. §113 (first sentence). (See: MPEP §601.01³)

This application contains method claims, e.g., claims 13 - 21. Therefore, the application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP §601.01(g).⁴

³ The commentary at MPEP §601.01 provides in pertinent part:
* * *

601.01(f) Applications Filed Without Drawings

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(1)(B) each provide, in part, that an “application shall include . . . a drawing as prescribed by section 113 of this title” and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the “filing date . . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. 113 (first sentence) in turn provides that an “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications.

* * *

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed for examination, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO.

* * *

⁴ The commentary at MPEP §601.01 provides in pertinent part:
* * *

601.01(g) Applications Filed Without All Figures of Drawings

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a “Notice of Omitted Item(s)” indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification. The mailing of a “Notice of Omitted Item(s)” will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the drawing(s) at

It appears that a "Notice of Omitted Items" should have been mailed instead of the "Notice of Incomplete Nonprovisional Application."


Therefore, the 23 August, 2001, and the 11 December, 2001, "Notice of Incomplete Nonprovisional Application" hereby are vacated.

The application is accorded a filing date of 22 June, 2001.

The petition is granted in part, to the extent that the application will be accorded the filing date of 22 June, 2001, without the drawing containing Figures 1 through 6 as part of the original disclosure of the application.

The application file is being returned to the Office of Initial Patent Examination for further processing with a corrected filing date of 22 June, 2001, indicating in the Office records that "0" sheets of drawings were present on filing, and the mailing of a corrected filing receipt.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)305-9199:



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Office of the Deputy Commissioner
for Patent Examination Policy

issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the drawing(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the "Notice of Omitted Item(s)," file a petition under 37 C.F.R. 1.53(e) with the petition fee set forth in 37 C.F.R. 1.17(h), along with evidence of such deposit (37 C.F.R. 1.181(f)). The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the USPTO with the application papers deposited on filing.

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